

REMARKS

Claims 1-7 and 9-16 are pending in the application. Independent Claims 1, 9, and 10 have been amended and Claims 11-20 are new. Support for the amendments can be found on page 3, paragraph 4 and in Tables 1 and 2 of the original specification. No new matter has been added.

REJECTIONS UNDER 103

Claims 1-4, 6-7, and 9-10 stand rejected under 35 USC 103(a) as being unpatentable over U.S. Patent No. 6,040,382 to Hanes et al. (hereinafter "Hanes") in view of U.S. Patent No. 5,879,596 to Roach et al. (hereinafter "Roach")

It is well settled that to establish a *prima facie* case of obviousness, the USPTO must satisfy all of the following requirements. First, the prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or to combine references. *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Second, the proposed modification does not have a reasonable expectation of success, as determined from the vantage point of one of ordinary skill in the art at the time the invention was made. *Amgen v. Chugai Pharmaceutical Co.* 18 USPQ 2d 1016, 1023 (Fed Cir, 1991), *cert. denied* 502 U.S. 856 (1991). Third, the prior art reference or combination of references must teach or suggest all of the limitations of the Claims. *In re Wilson*, 165 USPQ 494, 496, (CCPA 1970).

The Examiner alleges that Hanes discloses all of the elements of Applicants' invention except for the weight average molecular weight limitation and argues that the disclosure of Roach would provide teaching regarding the average molecular weight that would lead a skilled artisan to the Applicants' claimed invention with only routine experimentation absent any showing of surprising or unexpected results.

Applicants respectfully disagree. Amended independent Claim 1 is directed to a copolymer having a "weight average molecular weight of 60 to 240" (emphasis added). The Examiner concedes that Hanes fails to describe teach or suggest the weight

average molecular weight of the disclosed polymers. However, Roach fails to describe, teach or suggest the limitation that the weight average molecular weight of the copolymer is 60 240, nor does Roach provide a means at arriving at these values. Therefore, Roach fails to provide the missing limitation and, consequently, fails to cure the deficiencies of Hanes.

Furthermore, the Examiner correctly points out that "Hanes discloses a polymer blend containing three polymeric materials that are said to be 'transparent'" (emphasis added). Hanes achieves clarity by selectively mixing miscible polymers to bring the refractive indices close to that of the third immiscible polymer. When mixed, a thermoplastic molding with high clarity is formed. Surprisingly, Applicants achieve similar clarity using only two components. Amended independent Claims 1, 9, and 10 are directed towards a thermoplastic molding composition having high clarity that is made up of a styrene copolymer and a rubber component, and Claims 11-16 have been added to provide clarification regarding the transparent properties of the presently claimed molding. Applicants submit that Hanes fails to provide any description, teaching, or suggestion that a thermoplastic molding having high clarity can be produced using only two component polymers. Furthermore, Roach fails to describe teach or suggest a method of making a thermoplastic molding having high clarity that contains two components and, therefore, fails to cure the deficiencies of Hanes.

Moreover, Applicants continue to assert that the teachings of Roach are non-analogous art. Roach describes a process for making polyurethane at low temperatures that can be used to spin spandex. The Examiner points to Roach (column 5, lines 18-32) and, in particular, the description of the molecular weight distribution as "an important variable" that "contributes to many physical properties and processing characteristics" (lines 23-25) with particular emphasis on this passage in regards to processability. However, Roach fails to describe, teach or suggest specific weight average molecular weights for the copolymers recited in amended independent Claims 1, 9 and 10 to achieve any particular property, nor does Roach teach or suggest the relationship of the molecular weight distribution to clarity. Consequently, Roach

provides no description, teaching or suggestion relevant to the current claimed invention, and one of ordinary skill in the art would not look to the teachings of Roach to make a thermoplastic molding containing the copolymers of amended independent Claims 1, 9 and 10 with high clarity. Furthermore, there is no description, teaching or suggestion in either Hanes or Roach that would motivate a skilled artisan to combine either reference with the other.

Consequently, the Examiner has failed to make a *prima facie* case for obviousness under 35 USC 103(a) as Hanes, either alone or in combination with Roach, fails to render obvious the invention of amended independent Claims 1, 9 and 10. Reconsideration is respectfully requested.

Claims 2-7 and 11-20 depend from and added further limitations to amended independent Claims 1 and 10 and are deemed allowable for at least the same reasons in combination with amended independent Claims 1 and 10. Reconsideration is respectfully requested.

Claims 1-7, 9, and 10 stand rejected under 35 USC 103(a) as being unpatentable over U.S. Patent No 5,180,535 to Yamaoka et al. (hereinafter "Yamaoka") in view of Roach and Hanes.

The Examiner alleges that Yamaoka describes all of the elements of Applicants' invention, except for the average weight molecular weight limitations and the monomer concentrations, but that the number average molecular weight and monomer concentration would have been obvious to one of ordinary skill in the art in view of Roach. In addition, the Examiner alleges that Hanes discloses methods for conferring transparency, and it would have been obvious to confer transparency on the composition of Yamaoka in light of Hanes.

Applicants respectfully disagree. The Examiner concedes that Yamaoka is silent as to their composition. As discussed above, Roach fails describe, teach or suggest the specific weight average molecular weight of the copolymer as recited in amended independent Claims 1, 9 and 10 and, therefore, fails to cure the deficiencies of Yamaoka.


Furthermore, combination of Hanes with Yamaoka would fail to result in a transparent molding having two components as described in amended independent Claims 1, 9 and 10, as the method by which Hanes confers transparency requires the addition of a third polymer.

Accordingly, the combination of Yamaoka in view of Roach and Hanes fails to render obvious the invention of amended independent Claims 1, 9 and 10. Reconsideration is respectfully requested.

Claims 2-7 and 11-20 depend from and added further limitation to amended independent Claims 1 and 10 and are deemed allowable for at least the same reasons in combination with amended independent Claims 1 and 10. Reconsideration is respectfully requested.

It is believed that pending Claims 1-7 and 9-16 are now in condition for allowance and notice to such effect is respectfully requested. Should the Examiner have any questions regarding this application, the Examiner is invited to initiate a telephone conference with the undersigned.

Respectfully submitted,

By 
Jill Denesvich
Attorney for Applicants
Reg. No. 52,810

March 28, 2006

LANXESS Corporation
Law & Intellectual Property Department
111 RIDC Park West Drive
Pittsburgh, Pennsylvania 15275-1112
(412) 809-2232
FACSIMILE PHONE NUMBER:
(412) 809-1054

/lmr

S:\Law Shared\SHARED\JD\PATENTS\7942\3-28-06 ResponseCW.doc